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PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	09/557,149
		Filing Date	Apr 25, 2000
		First Named Inventor	Yohanan
		Group Art Unit	2174
		Examiner Name	SAX, STEVEN PAUL
Total Number of Pages in This Submission		Attorney Docket Number	MS1-1074USC3

ENCLOSURES (check all that apply)

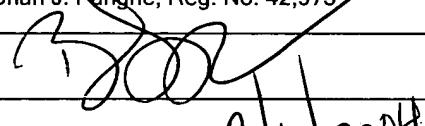
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) Sheets <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
Remarks		

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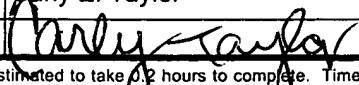
Technology Center 2100

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Brian J. Rangrie, Reg. No. 42,973
Signature	
Date	3/1/2004

CERTIFICATE OF EXPRESS MAILING

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PTO/SB/17 (10-03)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 330.00)

Complete if Known	
Application Number	09/557,149
Filing Date	Apr 25, 2000
First Named Inventor	Yohanan
Examiner Name	SAX, STEVEN PAUL
Art Unit	2174
Attorney Docket No.	MS1-1074USC3

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MAR 08 2004

METHOD OF PAYMENT (check all that apply)

Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number	12-0769
Deposit Account Name	Lee & Hayes, PLLC

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below Credit any overpayments
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 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)		(\$ 0.00)	

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20** =	X	=
			-3** =	X	=

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)		(\$ 0.00)

**or number previously paid, if greater; For Reissues, see above

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	330
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify)			
*Reduced by Basic Filing Fee Paid			
SUBTOTAL (3)		(\$ 330.00)	

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	Brian J. Pengrie	Registration No. (Attorney/Agent)	42,973	Telephone (509) 324-9256
Signature		Date	3/1/2004	

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EV369763615
#24
of 4



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/557,149
Filing Date July 9, 1999
Inventorship Yohanan
5 Assignee Microsoft Corporation
Group Art Unit..... 2174
Examiner S. Sax
Attorney's Docket No. MS1-1074USC3
Title: Graphical Method and System for Accessing Information on a
10 Communications Network

REPLY BRIEF TO THE BOARD OF PATENT APPEALS AND
INTERFERENCES OF THE UNITED STATES PATENT OFFICE FILED IN
RESPONSE TO THE EXAMINER'S ANSWER

15 To: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

From: Brian J. Pangre
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
20 Spokane, WA 99201

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Appellant's Reply Brief on Appeal

This reply brief is presented in support of the Notice of Appeal filed on
May 12, 2003 from the final rejection of claims 3-12 of the above identified
25 application and in support of Appellant's Opening Brief, filed on October 14,
2003. The Final Office Action which Appellant hereby appeals was mailed
March 12, 2003.

The Reply Brief is filed in triplicate. Please charge any additional
required fees or credit overpayment to Deposit Account 120769. Appellant
30 respectfully requests reversal of the Office's rejection of pending claims 3-12.

Reply Argument

Acknowledgement of Appellant's Opening Brief's conformity with formalities is appreciated. Arguments are presented below in accordance with

5 the Examiner's Answer mailed December 29, 2003, as presented under the heading "Response to Argument".

Appellant notes that the Examiner's Answer bears an incorrect date stamp of **December 29, 2001** and that formatting errors have resulted in some words being partially or wholly deleted.

10

Temporal Perspective – Relevant Dates

The Examiner's Answer states that "the patents over which the current 103 rejection was made date back to well before January of 1995, and thus the timing for obviousness is temporally consistent" (Examiner's Answer at page 3).

15 For ease of reference, and to establish a proper temporal perspective, Appellant presents specific dates below.

The Doyle patent (U.S. Pat. No. 5,838,906) was filed on October 17, 1994. This is less than two and a half months prior to January 1995. Further the parent application to the instant application (U.S. Pat. No. 5,737,560) included an unredacted email as part of an affidavit filed pursuant to 37 CFR 1.131 (see Image 1, below). In the affidavit, the applicant (Silicon Graphics, Inc.) of the instant (now Microsoft Corporation) application claimed a date of November 22, 1994. This is approximately one month after the filing date of the Doyle patent. Appellant submits that a proper timeline must be established to avoid improper hindsight reconstruction – noting that an obviousness analysis under §103 includes a myriad of factual inquiries.

With respect to the Cardinal patent (U.S. Pat. No. 5,799,318), the priority date is April 13, 1993, which is just over one and a half years prior to January 1995. As in any legal or administrative proceeding, where quantitative

30 information is available, it should be relied upon instead of qualitative

statements regarding time. Thus, for this particular Appeal, the relevant date for the Cardinal patent should be April 13, 1993 and, for the Doyle patent, it should be October 17, 1994. The relevant date for the instant application should be November 22, 1994 per the evidence submitted in the affidavit of the
5 parent application (see also Image 1, below).

Motivation - Problem to be Solved

Regarding motivation to combine references, the Examiner's Answer states:

10 The motivation to combine references lies in convenient resources to which data objects may be linked – both references have that. Then Doyle et al shows a convenient example of the resource being the web. Cardinal et al show the launching of the browser which links to data objects, and Doyle et al show the links to the web.

15 Examiner's Answer at pages 3, 4.

Appellant disagrees and reiterates that there is no suggestion to modify the cited prior art and that even assuming that such a suggestion existed, one of ordinary skill in the art would not arrive at the claimed subject matter. For these reasons alone, Appellant asserts that the Office has failed to make a
20 prima facie case of obviousness.

Further, even if a prima facie case of obviousness has been established, the Office must weigh secondary considerations presented by an applicant, which can include evidence of factors tending to show nonobviousness, such as commercial success of the invention, satisfying a long-felt need, failure of

25 others to find a solution to the problem at hand, and copying of the invention by others. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). To this end Appellant submits that the prosecution histories of the instant application and its related cases (U.S. Pat. Nos. 5,737,560; 5,877,767; 6,072,491) include evidence sufficient to
30 demonstrate nonobviousness of the claimed subject matter and to overcome

any prima facie obviousness rejection based on the Cardinal reference and the Doyle reference.

With respect to these foregoing bases for reversal, Appellant submits that one may look to the "problem to be solved" to realize that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the claimed subject matter.

The problem to be solved has been stated succinctly in the prosecution history. Image 1, below, is a scanned copy of an unredacted email submitted as an attachment to a Declaration under 37 CFR §1.131 on April 30, 1996 in parent case 08/580,742 (U.S. Pat. No. 5,737,560). This email is not new evidence as discussed under MPEP §1208.03 as it is part of the prosecution history of the instant application and the parent application. This email is provided herein to facilitate review of this Appeal. A redacted copy of this email was submitted in the instant application on November 17, 2001; thus, the text of the email is also part of the intrinsic record of the instant application.

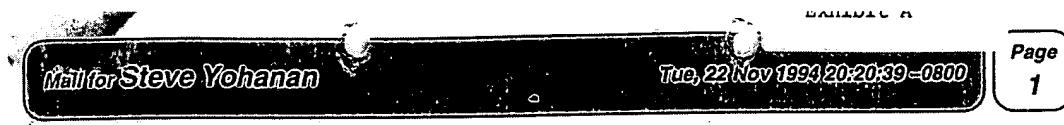
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25

30

IMAGE 1

5



From:yohanan Tue Nov 22 20:20:40 1994
From: "Steve Yohanan" <yohanan@coltrane.esd.sgi.com>
To: oz_engr@newmedia
Subject: You like the Desktop and you like the Web...
Date: Tue, 22 Nov 1994 20:20:39 -0800

Last week at lunch several of us were discussing some of the problems associated with navigating the Web. One of the things brought up was how to organize all the many URLs you get ahold of. One thing I did was build an FTR to hold a single Hotlist entry allowing you to simply double-click the icon and have it run your net browser of choice.

The format of the file is as such:

Fname extension: ".www"
First Line: Text Explaining the enclosed URL
Second Line: The URL

Now you can setup a directory which contains all your URLs or an Icon Catalog page with them as well.

The default browser is "netscape", then "Mosaic". -- both can be overriden by using the environ. variable WWWBROWSER. Attached is the FTR and an example "WWW Hot File". Play around with them and shoot any comments back through mail.

--
Steve Yohanan
yohanan@sgi.com [backpack]
(415) 390-1793 [backlash]

[Text] :

Under the "Subject" heading, the email reads "You like the Desktop and you like the Web . . . ", which may be viewed as a scope of subject matter. The 10 message body then states "[L]ast week at lunch several of us were discussing some of the problems associated with navigating the Web" and "[O]ne of the things brought up was how to organize all the many URLs you get ahold of." The inventor then states "One thing I did was build an FTR to hold a single Hotlist entry allowing you to simply double-click the icon and have it run your 15 net browser of choice."

From this evidence, the nature of the problem to be solved is associated with navigating the Web and organizing URLs and the scope of the solution

includes the desktop and the Web. In contrast, as stated in the Examiner's Answer at page 3, the nature of the concocted problem appears to be associated with linking convenient resources and data objects (i.e., "convenient resources to which data objects may be linked") and the scope appears to be 5 very broad and with little limit. In general, as the scope of a problem broadens, the evidence to show a motivation to combine the disparate references becomes more tenuous.

To properly address the issues presented herein, Appellant submits that the Office should consider the correct problem, in nature and scope, and, in so 10 doing, it should rely on the evidence of record, primarily the hand of inventor Yohanan. Indeed, without the correct problem how could one judge failure of others to find a solution to the problem at hand? How could one find a motivation?

Importantly, given the correct problem, Appellant submits that there is no 15 motivation to combine the Cardinal reference and the Doyle reference. The Cardinal reference does not mention the Web and the browser that the Cardinal reference does mention is simply not a Web browser. Appellant can only ponder how one of ordinary skill in the art would view the Cardinal reference given the correct problem. Which begs the question, what would motivate one 20 to read the Cardinal reference? And, if one did read it, what would he or she learn about Web browsers, URLs, navigating the Web? Little to nothing.

With respect to the Doyle reference, one of ordinary skill in the art may be expected to learn about modifying Web browser software to parse 25 hypermedia and hypertext documents. As for navigating the Web, Appellant fails to see how the Doyle reference teaches anything about such navigation – i.e., getting from one place to another. In contrast, the instant application provides a clever solution to navigate the Web whereby a user may simply click on a desktop icon.

For at least the foregoing reasons, Appellant submits that the rejected claims are allowable over the cited references and that the decision of the Examiner should be reversed.

5 Evidence of Secondary Considerations

Appellant submits that the strongest evidence came from the hand of the inventor when he solved the problem addressed by his colleagues. Appellant submits that Silicon Graphics, Inc. played an important role in the development of computers and software and that the current assignee has played an

10 important role in the development of computers, software and the Web. Indeed, today, the widespread use of desktop icons to launch a Web browser and to navigate to a Web site demonstrates commercial success.

Further, the prosecution histories show a heightened level of due diligence by both original assignee Silicon Graphics, Inc. and current assignee

15 Microsoft Corporation. On April 30, 1996, original applicant and assignee Silicon Graphics, Inc. filed a Petition to Make Special under 37 CFR §1.102(d) along with a detailed information disclosure statement stating that "a thorough and careful search was conducted in the United States Patent and Trademark Office (PTO)" wherein Supervisory Patent Examiner (SPE) Heather Herndon 20 and Examiner John Breene of Art Group 2400 and SPE Thomas Lee of Art Unit 2317 were consulted regarding the search. The original applicant/assignee even went further and conducted a keyword computer database search in the "USPAT" file and the "JPO" file of the Automated Patent System (APS). In addition, an on-line search of the internet was performed.

25 The current assignee, Microsoft Corporation, recognized that the duty of disclosure transferred as a result of the assignment. In response, Microsoft Corporation queried developers of operating systems such as the WINDOWS 95® operating system as to their knowledge of any related art. As a result of this search, a supplemental IDS was filed on July 12, 2002. The art included

30 information regarding operating systems that predated the WINDOWS 95®.

The art also included an article dated August 17, 1995, which stated "users can go from their desktops to any of their favorite Web sites just by clicking a single icon, without having to launch their connectivity software separately . . . and navigate to the desired Web sites." (emphasis added) from document "Microsoft

5 Introduces Internet Explorer, Internet Browser Designed Specifically for Windows 95 Offers Customers Easy Access to the Internet", August 17, 1995, submitted in Supplemental IDS dated July 12, 2002.

Appellant has emphasized the word "navigate" for this was the word used at or near the time of invention of the claimed subject matter. Again, this 10 evidence demonstrates that the problem to be solved and solved by inventor Yohanan was associated with navigation of the Web. The Cardinal reference simply does not address navigation of the Web and the Doyle reference is directed to modification of Web browser software for hypertext and hypermedia documents not to methods of Web navigation.

15 This evidence supports nonobviousness of the claimed subject matter. In particular, it is evidence of commercial success of the invention, evidence of satisfying a need perceived by highly skilled developers at Silicon Graphics, and perhaps even evidence of copying of the invention by others.

20 Claim Groups

Group I: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claims 3, and 9-12, which recite a desktop icon on a desktop associated with an address of a web site wherein selection of

25 the desktop icon by a user launches a web browser application that can access the web site using the address. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the 30 subject matter of claims 3 and 9-12.

Group II: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claim 4, which recites a desktop icon

5 associated with a file containing information relating to a web site accessible via a web browser application wherein the web browser application is separate from the file. The Cardinal reference does not mention the Web and hence does not disclose, teach or suggest anything about a file containing information relating to a web site. Appellant reiterates that (i) there is no suggestion to

10 modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the subject matter of claim 4.

15 Group III: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claim 5, which is an independent claim directed to a graphical computer system for accessing a desired document located at a network location. Claim 5 recites retrieving the desired document

20 from a network location using a web browser application and a network address via selection of a desktop icon associated with a file containing the network address that corresponds to the network location of the document wherein the web browser application is separate from the file. The Cardinal reference does not mention the Web and hence does not disclose, teach or suggest anything

25 about a Web browser application separate from a file containing a network address that corresponds to the network location of a document. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly

30 demonstrate nonobviousness of the subject matter of claim 5.

Group IV: Appellant submits that the foregoing presentation of arguments and citation of evidence of record provide sufficient bases for reversal of the Examiner's decision with respect to claims 6, 7 and 8. Claim 6 is an independent claim while claims 7 and 8 depend on claim 6. Claim 6 is directed to a method. Claim 6 recites receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web site. Claim 7 recites receiving an email while claim 8 recites receiving an internet message. The Cardinal reference does not mention the Web and does not disclose, teach or suggest anything about receiving a desktop icon associated with a file from a second computer system wherein the file contains an address corresponding to a web site. Appellant reiterates that (i) there is no suggestion to modify the cited prior art, (ii) modification of the cited prior art would not lead to the claimed subject matter and (iii) evidence germane to secondary considerations overwhelmingly demonstrate nonobviousness of the subject matter of claims 6, 7 and 8.

Conclusion

It is respectfully submitted that the cited art does not render the claimed invention obvious and that therefore the claimed invention does patentably distinguish over the cited art. Further, various evidence of record supports non-obviousness of the subject matter of claims 3-12 (e.g., Declaration, Petition and articles on INTERNET EXPLORER® software). It is respectfully submitted that claims 3-12, as set forth in Groups I, II, III and IV, should therefore be allowed.

The Office has not made a prima facie case of obviousness for any of these Groups, in the alternative, assuming arguendo that a prima facie case has been established, evidence germane to secondary considerations supports nonobviousness and is sufficient to overcome such a prima facie case. Therefore, reversal of the Office's rejections of claims 3-12 is respectfully requested.

Respectfully Submitted,

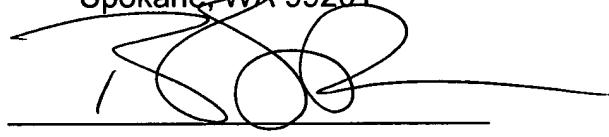
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Dated: 3/1/2001



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